

REMARKS

Claims 1, 10, 13, 17, 24, and 28 were rejected under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the enablement requirement. Claims 1, 3-7, 10, 11, 13-21, and 24 were rejected under 35 U.S.C. 103(a) as being anticipated by Moiroux et al. (US Patent No. 7,231,547) in view of Tallam (US Patent No. 6,948,099). Claims 8, 12 and 22 were rejected under 35 U.S.C. 103(a) as being unpatentable under Moiroux and Tallam in view of Neuman et al. (US PG PUB 20030217299). Applicants thank the Examiner for the telephone conversation on 06 August 2008 during which the aforementioned rejections were briefly discussed.

Regarding the rejections under 35 U.S.C. 112, first paragraph, Applicants continue to be surprised that the Examiner is not aware that the knowledge of one of skill in the art is sufficient to design a system that maintains the integrity of a volatile memory during a reboot sequence. Many such systems already exist. For example, processors often have a software instruction that can be invoked to initiate a reboot sequence without requiring that power be cycled or that memory be erased. Furthermore, publicly available patents deal with this issue. See, for example, US Patent 5,758,170 assigned to Dell USA, LP and US Patent 6,925,557 assigned to IBM Corporation, the assignee of the present application.

Applicants assert that a reboot sequence that maintains the integrity of volatile memory is well known art – particularly for storage subsystems which is the environment for which the present invention was developed. Should the Examiner be aware of a particular type of computing system for which maintaining the integrity of a volatile memory may remain an issue, Applicants remind the Examiner that it is not necessary to enable the invention in all possible environments or systems. Applicants also remind the Examiner of the standard for declaring a disclosure to be inadequate:

To establish a reasonable basis for questioning the adequacy of a disclosure, the examiner must present a factual analysis of a disclosure to show that a person skilled in the art would not be able to make and use the claimed invention without resorting to undue experimentation [*Emphasis Added*].

Applicants submit that the Examiner has not shown that a person skilled in the art would not be able to make and use the claimed invention without resorting to undue experimentation. Notwithstanding the foregoing, Applicants acknowledge the concern of the Examiner regarding

inoperable claims and have included the limitation “wherein the reboot occurs without a loss of data within the volatile memory” or the like within each of the independent claims to restrict the claimed inventions to operable embodiments and thereby address the Examiner’s concern. Applicants submit that the newly included limitation was a self evident limitation to one of skill in the art for the originally claimed invention particularly in light of the specification. Applicants therefore respectfully request that the amendment stand and the 35 U.S.C. 112 rejection be withdrawn.

Regarding the rejections under 35 U.S.C. 103(a), Applicants note that the Moiroux reference has a U.S. filing date of 29 April 2003. Applicants also note the requirement under 35 USC 102(e)(1) that “the invention was described in an application for patent ... before invention by the applicant for patent”. Applicants have attached hereto an internal disclosure document from IBM that is dated 22 October 2002. Applicants assert that the disclosure document shows that the Applicants were in possession of the claimed invention on or before 22 October 2002. The disclosure was followed with diligence in reduction to practice resulting in the filing of the present application on 16 October 2003.

Given the foregoing, Applicants submit that the cited reference of Moiroux is not prior art and the rejection under 35 U.S.C. 103 is improper. Applicants therefore assert that each of the pending claims is in condition for allowance. In the event any questions remain, the Examiner is respectfully requested to initiate a telephone conference with the undersigned.

Respectfully submitted,

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